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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|--------------------|
| 10/789,412 | 02/27/2004 | Bernd Klotz | KLOTZ-3 | 5250 |
| 20151 | 7590 | 04/05/2006 | EXAMINER | |
| HENRY M FEIEREISEN, LLC 350 FIFTH AVENUE SUITE 4714 NEW YORK, NY 10118 | | | | HUSON, MONICA ANNE |
| ART UNIT | | PAPER NUMBER | | |
| | | 1732 | | |

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------------------|-------------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/789,412 | KLOTZ, BERND | |
| | Examiner Monica A. Huson | Art Unit 1732 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 27 February 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.
 - 4a) Of the above claim(s) 7-11 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-6 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 27 February 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>052804</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6, drawn to a method of making, classified in class 264, subclass 328.7.
- II. Claims 7-11, drawn to an apparatus for molding, classified in class 425, subclass 542+.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process, such as one that does not require maintaining the size of the cavity constant while fully filling the cavity..

During a telephone conversation with Henry Feiereisen on 24 March 2006 a provisional election was made without oral traverse to prosecute the invention of Group I, claims 1-6. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on 27 August 2001. It is noted, however, that applicant has not filed a certified copy of the German application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrases "in particular" and "such as" render the claim indefinite because it is unclear whether the limitations following the phrases are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Takeda (U.S. Patent 5,776,407). Regarding Claim 1, Takeda shows that it is known to carry out a method of

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making a molded plastic article (Abstract), comprising the steps of closing a cavity of a positive mold by applying a clamping force (Column 8, lines 4-6); fully filling the cavity with plastic material, while maintaining a size of the cavity constant (Column 8, lines 21-22); adding plastic material so as to distend the positive mold in opposition to the clamping force until the positive mold reaches a defined article thickness (Column 8, lines 22-49); closing the positive mold until reaching a residual distending opening and molding the plastic material into a plastic article while applying the clamping force to thereby maintain the plastic material compressed (Column 9, lines 19-41); and removing the plastic article (Column 10, lines 20-30).

Regarding Claim 2, Takeda shows the process as claimed as discussed in the rejection of Claim 1 above, including a method wherein the adding step is controlled in dependence on a distance traveled by an advancing screw (Column 8, lines 23-25).

Regarding Claim 4, Takeda shows the process as claimed as discussed in the rejection of Claim 1 above, including a method further comprising the steps of measuring an internal pressure in the positive mold, and applying the clamping force in dependence on a profile of the internal pressure (Column 8, lines 21-54).

Regarding Claim 5, Takeda shows the process as claimed as discussed in the rejection of Claim 1 above, including a method further comprising the step of applying a higher clamping force upon the positive mold at a location closer to the sprue than at a location farther away from the sprue (Figures 12 and 13; Column 13, lines 1-3; e.g. compression is greater in the area of the molded article 106-107 than in the area to the left of elements 48-50).

Regarding Claim 6, Takeda shows the process as claimed as discussed in the rejection of Claim 1 above, including a method wherein the molding step is carried out at constant clamping force (Column 9, lines 38-42).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda, in view of Uchiyama et al. (U.S. Patent 6,328,920). Takeda shows the process as claimed as discussed in the rejection of Claim 1 above, but he does not show adding more resin depending on the distending motion of the positive mold. Uchiyama et al., hereafter "Uchiyama," show that it is known to carry out a method wherein the adding step is controlled in dependence on a distending motion of the positive mold (Abstract, i.e. the adding step is in dependence on the amount of movement of the positive mold). Uchiyama and Takeda are combinable because they are concerned with a similar technical field, namely, methods of injection compression molding. It would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to use Uchiyama's control theory during Takeda's molding process in order to avoid the need for screw position sensors and monitoring.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patent is cited to further show the state of the art with regard to injection compression molding processes:

U.S. Patent 5,059,364 to Okubo et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica A. Huson whose telephone number is 571-272-1198. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Colaianni can be reached on 571-272-1196. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Monica A Huson
March 30, 2006


MICHAEL P. COLAIANNI
SUPERVISORY PATENT EXAMINER